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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/722,840	11/25/2003	T. Clare Huang	42053.86USPT	8196

7590 09/27/2005

Shell Oil Company
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EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/722,840

Applicant(s)

HUANG ET AL.

Examiner

Margaret G. Moore

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 to 6, 8 to 22, 24 to 28 and 30 to 37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 to 6, 8 to 22, 24 to 28 and 30 to 37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 1 to 6, 8, 9, 12 to 15 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Klayder et al.
3. Claims 16, 17, 21, 22, 24 to 28, 30, 31 and 34 to 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Klayder et al.
4. Both of these rejections are based on the rationale of record and as such this will not be repeated. Applicants have amended claim 1 such that the wetting agent must be a polyalkyleneoxide modified heptamethyltrisiloxane. Applicants argue that the Silwet 7606 used in Example 2 does not meet this wetting agent. The bottom of column 4 in Klayder et al. teach, as a preferred surfactant that can be used in this composition, Silwet 7607. As can be seen from the supporting evidence in Mondin et al., the bottom of column 10, Silwet 7607 is a polyalkyleneoxide modified heptamethyltrisiloxane. Klayder et al. teach a very limited number of surfactants that can be added to the composition therein and in view of this limited selection Klayder et al. anticipate the use of Silwet 7607. As such this amendment is not sufficient to overcome the teachings in Klayder et al.
5. Claims 1, 3, 5, 6, 8, 18 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Mondin et al.

Mondin et al. teach a microemulsion composition. Particular attention is drawn to the examples such as D and E which contain Silwet 7608 (polyalkylene oxide modified heptamethyltrisiloxane) and a silicone antifoam. This meets the requirements of claims 1, 3, 6 and 8. Note the additional surfactants, such as the nonionic defoamer, which meet claim 5. Column 13, lines 19 and 20, teach that this is a sprayable composition that can be in an aerosol container. This anticipates claims 18 and 19.

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6. Claims 10, 11, 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondin et al.

For claims 16 and 17, column 13, line 20, teaches packaging the product in a pump type sprayer container. The selection of conventional plastic bottles such as PVC or PET for the sprayer in Mondin et al. would have been obvious to one having ordinary skill in the art. This is comparable to the rationale noted in paragraph 7 of the office action dated 9/28/04.

For claims 10 and 11, Mondin et al. do not expressly teach the addition of a propellant; however, one would necessarily be present in an aerosol container. In lack of any express teaching as to what type of propellant to select, the skilled artisan would have been motivated to select one that is known and commonly used in the art. In addition, one would have been directed towards propellants that are approved by the EPA for use in aerosol formulations. 1,1,1,2-tetra fluoroethane is such a propellant (see applicants' admission on page 5 of the specification). As such one having ordinary skill in the art would have found the selection of such a propellant to have been obvious.

7. Claims 1 to 6, 8 to 12, 14 to 19, 21, 22, 24 to 28, 30 to 34, 36 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Estes in view of Parkinson et al.

The teachings in Estes have been detailed in previous office actions. Generally Estes teaches a rubber protectant which contains a silicone microemulsion (top of col. 2 and various working examples). The silicone fluid has a viscosity within the range of claims 2 and 4 and can have amino functional groups (column 2, lines 3 to 35). This composition contains surfactants (column 2, line 66 and on) as well as antifoaming agents, corrosion inhibitors, freezing point depressants (column 6, lines 57 to 63). The composition can be either an aerosol or a spray in a pump or trigger container. Again, note the details of the previous rejections as they presently apply to each of the claims.

Estes teaches on column 12, line 38, that various wetting agents can be added to improve wetting and make application easier. Estes does not specifically teach poly-alkyleneoxide modified heptamethyltrisiloxane wetting agent.

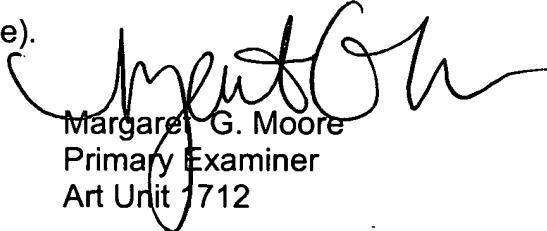
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Parkinson et al. teach treatment compositions for various surfaces such as rubbers. This composition is a silicone emulsion. Column 6 teaches various wetting agents and the benefits thereof, such as uniform coating and improved penetration. Among the wetting agents are Silwet L-77 and 7607, which are polyalkyleneoxide modified heptamethyltrisiloxanes. (Again, this is supported by the teachings in Mondin et al. Note too column 3, lines 28 to 34 in 6,221,811) As can be seen from the performance rating of these wetting agents, they provide benefits and desired wetting properties to the composition of Parkinson et al.

Thus one having ordinary skill in the art would have been motivated by the teachings in Parkinson et al. to add a polyalkyleneoxide modified heptamethyltrisiloxane wetting agent to the composition of Estes et al. in an effort to obtain the properties and benefits thereof. It is prima facie obvious to add a known ingredient to a known composition for its known function. In this manner the instant claims are rendered obvious.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 571-272-1090. The examiner can normally be reached on Monday to Wednesday and Friday, 10am to 4pm.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
9/21/05